

REMARKS

Applicant has carefully studied the Office Action of 25 September 2003 and offers the following remarks to accompany the above amendments.

Initially, the Patent Office objected to the Abstract as being too long. Applicant herein amends the Abstract to tighten the language such that the word count is now less than the mandated 150 words. Applicant requests withdrawal of the objection to the abstract at this time.

Applicant further amends claim 40 to correct the preamble. No new matter is added, but the method nature of the claim is confirmed in light of its dependency.

Before addressing the rejections of the claims based on the references, Applicant provides a brief summary of the present invention so that the rest of the remarks are placed in the proper context. The present invention is directed to a portable device that has software stored thereon. The portable device is designed to be connected to a host computing device. When the portable device is connected to the host computing device, the software on the portable computing device is designed to execute automatically. In a particularly claimed embodiment, the software provides an interface frame on the display of the host computing device.

Claims 1, 5-9, 11-15, 17, 21-25, 27-29, 33-37, and 39-40 were rejected under 35 U.S.C. § 102(e) as being anticipated by Herrendoerfer et al. (hereinafter "Herrendoerfer"). Applicant respectfully traverses. For the Patent Office to prove anticipation, the Patent Office must show where every element of the claim is present within the reference. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. If the Patent Office cannot show this identity of elements, then the claims are not anticipated, and Applicant is entitled to a patent.

In this rejection, the Patent Office is overlooking certain elements within the independent claims which are not present in Herrendoerfer. For example, claim 1 recites that there is "software for executing on a host computing device" Claim 17 has a similar element, namely "software to reside on a portable device . . ." and claim 29 recites "software residing on a portable computing device" Likewise, the claims all recite that the software is designed to automatically execute on a host computing device. The Patent Office groups its analysis of claims 1, 17, and 29 and opines that Herrendoerfer shows memory containing software for executing on a host computing device 118, but offers no citation as to where in the reference the software that executes on a host computing device can be found. The Patent Office further opines that the software is adapted to automatically execute on the host computing device, but

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again offers no citation as to where in the reference this element is shown. The only citation is to column 3, lines 4-11, which indicates that the proxy server acts as an interface between the client and the smart card. Applicant has carefully studied the reference and finds no teaching or suggestion that the information on the smart card 130 is software designed to execute on the host computing device. Even if the information on the smart card 130 is determined to be software, there is no teaching or suggestion that the information on the smart card 130 is designed to execute automatically on the host computing device. To support this position, Applicant notes that in every instance that the reference discusses accessing the smart card 130, only data is accessed, and the data is then inserted into an HTML document (see abstract, lines 6, 11-14, 16, 18; column 1, lines 52, 55, 59; column 2, lines 7-8, 18-19; etc.¹). While the Patent Office is entitled to give claim terms their broadest reasonable definitions, the reasonableness is determined from the perspective of one of ordinary skill in the art. To someone of ordinary skill in the art, data on a smart card that is read from and written to the smart card is not the same as software, and is certainly not the same as software that executes automatically on the host computing device. Thus, these elements are not shown by the reference, and an anticipation rejection is improper. Since the independent claims are not anticipated, the claims which depend therefrom are not anticipated.

In light of the foregoing, Applicant requests withdrawal of the § 102 rejection of claims 1, 5-9, 11-15, 17, 21-25, 27-29, 33-37, and 39-40 at this time.

Claims 2-4, 18-20, and 30-32 were rejected under 35 U.S.C. § 103 as being unpatentable over Herrendoerfer in view of Suga et al. (hereinafter "Suga"). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the references. Furthermore, the Patent Office must show objective evidence as to why it is proper to combine the references. MPEP § 2143.03. If the Patent Office cannot fill both these requirements, then Applicant is entitled to a patent.

As explained above, Herrendoerfer does not teach or suggest that there is software on the portable device, much less that there is software that is designed to execute automatically on the host computer. Nothing in Suga cures this deficiency, and thus, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie*

¹ Even the passage cited by the Patent Office (column 3, lines 4-11) reflects that it is only data that is being accessed on the smart card. Again, there is no mention that the smart card stores software thereon that is designed to execute automatically on the host computing device.

obviousness, the claims define over the cited art. Applicant requests withdrawal of the § 103 rejection of claims 2-4, 18-20, and 30-32 at this time.

As further evidence that the Patent Office has not established *prima facie* obviousness, there is no objective evidence as to why one of ordinary skill in the art would combine Herrendoerfer with Suga. While the Patent Office opines that it would have been obvious "with the motivation being to help use to easily and quickly access functions," there is no objective evidence to support this motivation. Since the Patent Office has not properly supported the motivation to combine the references, the combination is improper.

Claim 16 was rejected under 35 U.S.C. § 103 as being unpatentable over Herrendoerfer in view of Yee et al. (hereinafter "Yee"). Applicant respectfully traverses. The standard for obviousness is set forth above.

As explained above, Herrendoerfer does not teach or suggest that there is software on the portable device, much less that there is software that is designed to execute automatically on the host computer. Nothing in Yee cures this deficiency, and thus, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie* obviousness, the claims define over the cited art. Applicant requests withdrawal of the § 103 rejection of claim 16 at this time.

As further evidence that the Patent Office has not established *prima facie* obviousness, there is no objective evidence as to why one of ordinary skill in the art would combine Herrendoerfer with Yee. While the Patent Office opines that it would have been obvious "with the motivation being to enhance the portability of the system," there is no objective evidence to support this motivation. Since the Patent Office has not properly supported the motivation to combine the references, the combination is improper.

Claims 10, 26, and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Herrendoerfer in view of Zubeldia. Applicant respectfully traverses. The standard for obviousness is set forth above.

As explained above, Herrendoerfer does not teach or suggest that there is software on the portable device, much less that there is software that is designed to execute automatically on the host computer. Nothing in Zubeldia cures this deficiency, and thus, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie*

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obviousness, the claims define over the cited art. Applicant requests withdrawal of the § 103 rejection of claims 10, 26, and 38 at this time.

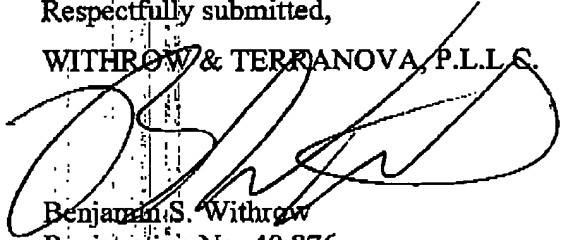
As further evidence that the Patent Office has not established *prima facie* obviousness, there is no objective evidence as to why one of ordinary skill in the art would combine Herrendoerfer with Zubeldia. While the Patent Office opines that it would have been obvious "with the motivation being to increase the protection of user's privacy," there is no objective evidence to support this motivation. Since the Patent Office has not properly supported the motivation to combine the references, the combination is improper.

For the foregoing reasons, Applicant requests reconsideration of the rejection. Specifically, the references of record do not teach or suggest software resident on the portable device, nor is there any teaching or suggestion that the software is adapted to execute automatically on the host computing device. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:


Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

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